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EXAMINER

NGUYEN, TRAN N

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KRISTIE INNOCENTI BERZANSKY, STATON MCCOMB,
BINNY JOHN, HAMSA KONANUR, DAVID BARBER, PARAS DESAI,
KRUTI GOSWAMI, DENIS WILLIAMS, and SHABARI MADAPPA

Appeal 2016-004098
Application 12/167,744
Technology Center 3600

Before MURRIEL E. CRAWFORD, NINA L. MEDLOCK, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 11–16, 34–43, and 45–56. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention is directed to methods and systems for managing medical information. Spec. 2.

Claim 11 is illustrative:

11. A method of tracking inventory of medical supplies for a medical service provider comprising:

- receiving a prescription identifier for a prescription to be stored in will call, wherein the identifier is selected from the group consisting of a scanned barcode and a keyed user input;

- receiving a designation of a physical location in which the prescription will be stored;

- associating, via a processor, the prescription identifier with the designation of the physical location received;

- providing for display upon a screen, via the processor, of a visual representation of a plurality of locations in a storage area, wherein each location represented corresponds to a physical location;

- providing for display upon the screen of an indication of prescription identifiers associated with each location represented, wherein the indication of prescription identifiers is displayed within the visual representation of the plurality of locations provided;

- determining whether further input received changing a configuration of the visual representation is allowable based on associations of prescription identifiers with corresponding designated physical locations existing at the time at which the further input is received, wherein the input requests deletion of at least one row or at least one column of the visual representation of the storage area; and

- precluding the change when the input received is not allowable.

Appellants appeal the following rejection:

Claims 11–16, 34–43, and 45–55 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

PRINCIPLES OF LAW

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–95 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Flook*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept” — an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

Using some unspecified, generic computer and in which each step does no more than require a generic computer to perform generic computer functions is not sufficient to circumvent the prohibition against patenting an abstract idea. *See Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010).

ANALYSIS

The Examiner held that the claims are directed to an abstract idea because they are directed to data processing in that the steps of the claims are performed on mere data, and include the steps of storing, sorting, categorizing and displaying data. Fin. Act. 10. The Examiner further stated

that the abstract concepts of the claims are concepts that the courts have found to be ineligible. Ans. 4. We agree.

We are persuaded that steps of claim 1 are similar to the steps that the Federal Circuit determined were patent ineligible in *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). In *Electric Power*, the method claims at issue were directed to performing real-time performance monitoring of an electric power grid by collecting data from multiple data sources, analyzing the data, and displaying the results. *Elec. Power Grp. LLC*, 830 F.3d at 1351–52. The Federal Circuit held that the claims were directed to an abstract idea, explaining that “[t]he advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” *Id.* at 1354.

We are not persuaded of error on the part of the Examiner by Appellants’ argument that the Examiner failed to provide a clear rationale and failed to specifically point out factual evidence in support of the finding that the claims are directed to an abstract idea. In our view, the Examiner’s statements are sufficient to place Appellants on notice as to step 1 of *Alice* as required under 35 U.S.C. § 132. *See In re Jung*, 637 F.3d 1356 (Fed. Cir. 2011). On the issue of prima facie notice, particularly to anticipation but also generally, our reviewing court was clear in *Jung* that:

There has never been a requirement for an examiner to make an on-the-record claim construction of every term in every rejected claim and to explain every possible difference between the prior art and the claimed invention in order to make out a prima facie rejection.

637 F.3d at 1363. The Federal Circuit further stated:

“[Section 132] does not mandate that in order to establish prima facie anticipation, the PTO must explicitly preempt every possible response to a section 102 rejection. Section 132 merely ensures that an applicant at least be informed of the broad statutory basis for the rejection of his claims, so that he may determine what the issues are on which he can or should produce evidence.”

Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (internal citation omitted). As discussed above, all that is required of the Office to meet its prima facie burden of production is to set forth the statutory basis of the rejection. As the statute itself instructs, the examiner must “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing prosecution of his application.” 35 U.S.C. § 132.

In the instant case, the Examiner’s discussion regarding the similarity of the claims to other claims found by courts to be ineligible was more than sufficient to meet this burden as to *Alice* step 1. Our reviewing court has stated that it is proper to look to other decisions where similar concepts were previously found abstract by the courts in determining whether claims are directed to an abstract idea. *See Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“Instead of a definition [for what an ‘abstract idea’ encompasses], then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”).

In regard to the second step of *Alice*, the Examiner found that the recited computer processor is no more than a generic/general purpose computer and further found that this is commensurate with the Specification as originally filed. Fin. Act. 10. The Examiner also found that the claimed processor when read in light of the Specification as originally filed appears to be any type of architecture capable of implementing the invention and, therefore, the broadest and most reasonable interpretation of the claims would be a generic/general purpose computer at best. Ans. 4.

We are not persuaded of error on the part of the Examiner by Appellants' argument that the Examiner failed to identify the specific limitations or provide any support or rationale as to why the claim recitations are not enough to qualify as "significantly more." We note that the Examiner specifically referred to the processor when determining whether the claims include "significantly more" and found that this processor is a general purpose computer.

We are not persuaded that the Examiner erred by Appellants' argument that the claimed invention provides a particular solution to a problem. As disclosed in the Specification, the problem addressed by the claimed invention is managing medical information for medical service providers to allow personnel to manage and track workflow operations, evaluate profitability, and maintain records. Spec. 1. As such, the problem solved by the instant invention is a medical business problem. The process of claim 11 does not improve an existing technological process or solve a technical problem. Even Appellants' more detailed description of its claimed subject matter relates to an abstract idea. Of course, the medical

business problem of the invention is solved using a processor and clearly there are advantages to doing so. This, however, does not, in itself, remove the claimed subject matter from the realm of the abstract as “necessarily rooted in technology.” *See Alice*, 134 S. Ct. at 2352 (holding a “computerized scheme for mitigating ‘settlement risk’ “ as unpatentable subject matter); *In re TLI Commc’ns Patent Litig.*, 823 F.3d 607 (Fed. Cir. 2016) (holding unpatentable a method for recording imaging with a phone, storing the images digitally, transmitting to a server and sorting based on classification information).

Appellants’ argument that the claims effect a transformation of particular articles is unpersuasive of error on the part of the Examiner. We agree with the Examiner’s response to this argument found on pages 5 to 6 of the Answer and adopt the response as our own.

Appellants argue that because the claims have been found to be novel and non-obvious the claims recite a specific combination of steps that compels the conclusion that the subject matter is patent-eligible. To the extent that this argument is that claim 11 necessarily amount to “significantly more” than an abstract idea because the claim is allegedly patentable over the prior art, Appellants misapprehend the controlling precedent. Although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Alice*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to

a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304.

Appellants argue the Examiner is required to address each claim individually and should not have judged the claims to stand or fall with similar claims. App. Br. 7.

We concur with the Examiner that the dependent claims are directed to nonstatutory subject matter for the same rationale as used in regard to claim 11. In this regard, the additional recitations in the dependent claims 12–16 and 34–41 further define the abstract idea of claim 11 and are thus directed to an abstract idea as well. Claim 42 is directed to a computer program that includes instructions to perform steps substantially as recited in claim 11. Claims 43 and 45–56 which depend from claim 42 like the claims which depend from claim 11, further define the abstract idea of claim 42.

Appellants’ arguments related to whether the claims are directed to a fundamental economic practice, a method of organizing human activities, and idea in and of itself, and a mathematical relationship/formula are not persuasive of error on the part of the Examiner because these arguments do not address the Examiner’s determination regarding the claims. The Examiner found that the claims are directed to storing, sorting, categorizing and displaying data. As we discussed above, the Examiner also correctly stated that courts have found that claims directed to storing, sorting, categorizing and displaying data are directed to an abstract idea.

DECISION

We affirm the Examiner’s § 101 rejection.

TIME PERIOD

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1) (2009).

ORDER
AFFIRMED